

REMARKS

By the present amendment, Claims 3 and 13 have been amended. Claims 3-22 are pending in the present application. Claims 3 and 13 are independent claims. Applicant respectfully requests reconsideration and allowance in view of the foregoing amendments and the following remarks.

Claims 3-22 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Witek et al. (U.S. Patent No. US 6,253,188 B1). Applicant respectfully traverses this rejection.

Applicant has amended Claims 3 and 13 to more particularly set forth the claimed invention. Applicant respectfully submits that the amendments to the claims overcome this rejection, are fully supported by the original disclosure, and introduce no new matter therewith.

Amended independent Claim 3 recites an electronic classified advertising system, and amended independent Claim 13 recites an electronic classified advertising method that each carry out steps including providing a multi-tier hierarchical structure with a top level sections menu and lower tier section menus, providing each section menu with a SEARCH ADS link, providing each section menu with a PLACE ADS link, providing each section menu with an EDIT ADS link, providing each section menu with a MY PROFILE link, providing each section menu with a MY CHECKLIST link, providing each section menu with an AUTO NOTIFY link, providing each section menu with a HELP link, providing each section menu with a BROWSE ADS link, providing each section menu with an ADVANCED SEARCH

link, providing each section menu with a POWER SEARCH link, publishing a classified advertisement, providing a search engine for plural types of searches including browsing, keyword searches, retrieval of a specific ad by a database identification number, retrieval of all of a particular users ads, retrieval of one particular ad for modification, and full database power searches, searching for classified ads by category and subcategory, posting new classified ads by end users, modifying, renewing, and deleting classified ads by end users, creating, modifying, and deleting a personal search agent to automatically send new classified ads by email that match predefined criteria, establishing advertisement response criteria; and privately and securely responding to electronic classified advertising.

Witek et al. describes a system and method for providing classified ads over the Internet. The system includes a plurality of regional newspaper World Wide Web Servers and associated newspaper classified ad generators; a central classified ad information collection and distribution facility and a central World Wide Web application server facility, all connected to the Internet such that Internet users can connect to the Newspaper Web server and central Web application sever facility to search for and obtain classified ads. The Web application server facility includes one or more application servers and one or more newspaper classified ad database servers. The system apparatus features elements which enable Internet users to enter the system at the newspaper Web server and subsequently search for classified ads held in the ad databases at the database servers through the application servers at the central Web server and subsequently search for classified ads held in the ad databases at the database servers through the application servers at the central Web application facility. Additionally, the system features elements

to enable users to search for the newspaper classified ads at the database servers using a client-server method that includes a common gateway interface procedure. Additionally, the system ad generator includes elements for automatically generating ad records for inclusion at the database servers of the central Web application facility which are derived from the newspaper print ad feed. Still further, the system includes elements at the collection and distribution facility for automatically collecting ads produced at the newspaper ad generators and providing them to the database servers on a scheduled basis. The method features steps for supporting the common-gateway-interface searching procedures which can be carried out in multiple stages. Additionally the method features steps for automatically generating classified ad record information in substantially numerical form which is pre-sorted to support improved speed in search the ad record databases.

The Examiner asserts that Witek et al. teaches the features set forth in Claim 3 and refers to the abstract, Figs. 14 and 16A, and the accompanying text in column 1, lines 24-65, column 3, lines 24-40, column 5, lines 11-15 and line 25 to column 6, line 33, and column 8, line 56 to column 9, line 2 as areas in Witek et al. where the features of Claim 3 are set forth.

Applicant has fully reviewed these portions of Witek et al. and respectfully submits that these portions of Witek et al. do not teach or reasonably suggest the features set forth in independent Claims 3 and 13. In particular, Applicant respectfully respectfully submits that the only section pointed to by the Examiner that describes the use of hierarchical menus, namely column 3, lines 24-40, describes their use in U.S. Patent No.

4,429,385 to Cichelli et al. Witek et al. expressly teaches away from the use of multiple menus in the Witek et al. system because they have the potential for being sluggish, would diminish the opportunity for associated or alternative ad selection, and would destroy the intended function of the Witek et al. system. It is well known that reference citations cannot be combined if the modification destroys the intended function of the reference. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicant also respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with a SEARCH ADS link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with a PLACE ADS link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with an EDIT ADS link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with a MY PROFILE link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with a MY CHECKLIST link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with an AUTO NOTIFY link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with a HELP link. Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with an ADVANCED SEARCH link.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests providing each section menu with a POWER SEARCH link.

With respect to Claims 4-22, the Examiner merely states that they disclose the same inventive concept as Claim 3 and, therefore, they are rejected under the same rationale. The Examiner fails to provide and/or cite any portions of Witek et al. that teach the features set forth in Claims 4-22. Applicant respectfully submits that it is improper to reject a claim under 35 U.S.C. § 102(e) because the claims allegedly "disclose the same inventive concept" as another claim.

It is well known that for a reference to anticipate a claim under 35 U.S.C. § 102(e) there "must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention" (see *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

Applicant respectfully submits that Witek et al. fails to anticipate and provides no motivation whatsoever to modify the teachings thereof to provide an electronic classified advertising system, or an electronic classified advertising method that each carry out steps including providing a multi-tier hierarchical structure with a top level sections menu and lower tier section menus, providing each section menu with a SEARCH ADS link, providing each section menu with a PLACE ADS link, providing each section menu with an EDIT ADS link, providing each section menu with a MY PROFILE link, providing each section menu with a MY CHECKLIST link, providing each section menu with an AUTO NOTIFY link, providing each section menu with a HELP link, providing each section menu with a BROWSE ADS link, providing each section menu with an ADVANCED SEARCH link, providing each

section menu with a POWER SEARCH link, publishing a classified advertisement, providing a search engine for plural types of searches including browsing, keyword searches, retrieval of a specific ad by a database identification number, retrieval of all of a particular users ads, retrieval of one particular ad for modification, and full database power searches, searching for classified ads by category and subcategory, posting new classified ads by end users, modifying, renewing, and deleting classified ads by end users, creating, modifying, and deleting a personal search agent to automatically send new classified ads by email that match predefined criteria, establishing advertisement response criteria; and privately and securely responding to electronic classified advertising, as Claims 3 and 13 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 4 and 14, respectively. Dependent Claims 4 and 14 recite that the step of providing each section menu with a SEARCH ADS link further carries out steps including searching for classified ads in the system by section (category) and subcategory.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests that a step of providing each section menu with a SEARCH ADS link that further carries out steps including searching for classified ads in the system by section (category) and subcategory, as Claims 4 and 14 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 4 and 14 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 5 and 15, respectively. Dependent Claims 5 and 15 recite that the step

of providing each section menu with a PLACE ADS link further carries out steps including posting new classified ads to the system.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with a PLACE ADS link further carries out steps including posting new classified ads to the system, as Claims 5 and 15 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 5 and 15 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 6 and 16, respectively. Dependent Claims 6 and 16 recite that the step of providing each section menu with a EDIT ADS link further carries out steps including modifying, renewing, deleting, or adding or modifying multimedia files to classified ads on the system.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with a EDIT ADS link further carries out steps including modifying, renewing, deleting, or adding or modifying multimedia files to classified ads on the system, as Claims 6 and 16 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 6 and 16 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 7 and 17, respectively. Dependent Claims 7 and 17 recite that the step of providing each section menu with a MY PROFILE link further carries out steps including

registering for an account or updating registration information for an account on the system.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with a MY PROFILE link further carries out steps including registering for an account or updating registration information for an account on the system, as Claims 7 and 17 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 7 and 17 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 8 and 18, respectively. Dependent Claims 8 and 18 recite that the step of providing each section menu with a MY CHECKLIST link further carries out steps including displaying all classified ads that have been marked for future recall and viewing by the system.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with a MY CHECKLIST link further carries out steps including displaying all classified ads that have been marked for future recall and viewing by the system, as Claims 8 and 18 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 8 and 18 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 9 and 19, respectively. Dependent Claims 9 and 19 recite that the step of providing each section menu with an AUTO NOTIFY link further carries out steps

including creating, modifying, or deleting a personal search agent that automatically sends new classified ads on the system by email that match pre-defined criteria.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with an AUTO NOTIFY link further carries out steps including creating, modifying, or deleting a personal search agent that automatically sends new classified ads on the system by email that match pre-defined criteria, as Claims 9 and 19 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 9 and 19 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 10 and 20, respectively. Dependent Claims 10 and 20 recite that the step of providing each section menu with a BROWSE ADS link further carries out steps including presenting a list of all classified ads on the system.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with a BROWSE ADS link further carries out steps including presenting a list of all classified ads on the system, as Claims 10 and 20 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 10 and 20 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 11 and 21, respectively. Dependent Claims 11 and 21 recite that the step of providing each section menu with an ADVANCED SEARCH link further carries out

steps including searching for classified ads using keyword searching, Boolean options searching, case-sensitive searching, date-ranging searching, or searching with imagery.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with an ADVANCED SEARCH link further carries out steps including searching for classified ads using keyword searching, Boolean options searching, case-sensitive searching, date-ranging searching, or searching with imagery, as Claims 11 and 21 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 11 and 21 require.

Additional features of the invention recited in Claims 3 and 13 are found in dependent Claims 12 and 22, respectively. Dependent Claims 12 and 22 recite that the step of providing each section menu with a POWER SEARCH link further carries out steps including searching for classified ads in the system based on specific criteria and within ranges.

Applicant respectfully requests the Examiner to specify where Witek et al. teaches or reasonably suggests a step of providing each section menu with a POWER SEARCH link further carries out steps including searching for classified ads in the system based on specific criteria and within ranges, as Claims 4 and 14 require. Applicant respectfully submits that Witek et al. provides no motivation whatsoever to modify the teachings thereof to provide the features Claims 12 and 22 require.

Applicant respectfully points out that the present Office Action is the third Office Action affecting the present application. Further, the Witek et al. patent that is applied in the

present April 18, 2005 Office Action, as well as the Minte et al. patent application publication cited in the December 3, 2004 Office Action, are both classified in class 705, subclass 14 which was initially searched by the Examiner for preparation of the first Office Action mailed June 2, 2004. These references were each cited after Applicant filed amendments September 2, 2004 and December 3, 2004, respectively.

Applicant respectfully reminds the Examiner that MPEP section 707(g) provides that piecemeal examination should be avoided as much as possible and that each claim should be rejected on "all valid grounds available". Furthermore, MPEP section 904.03 explains that for a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the Examiner reasonably anticipates might be incorporated into Applicant's amendment. In selecting the references to be cited, the Examiner should carefully compare the references with one another and with Applicant's disclosure. There is no apparent reason why the 35 U.S.C. § 102(e) rejection to Claims 13-22 under Witek et al. could not have been made in the September 2, 2004 Office Action and resolved at that time. Applicant respectfully submits that by citing the current Witek et al. patent, the Examiner has

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inappropriately added to the burden and cost of prosecution of the present application, which MPEP section 904.03 states should be avoided.

The present application has been pending for over four years and Applicant has already had a personal interview with the Examiner in an attempt to resolve all outstanding objections and rejections. Reconsideration is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T.C. Schoeffler', with a stylized flourish at the end.

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